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TRANSMITTAL OF APPEAL BRIEF (Small Entity)

Docket No.  
118776-1001

In Re Application Of: Brock, et al.

Serial No.	Filing Date	Examiner	Group Art Unit
09/327,593	June 8, 1999	S. Rimmel	2175

Invention: INTERCHANGEABLE PANEL, MODULAR DISPLAY SYSTEM

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TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

Applicant is a small entity under 37 CFR 1.9 and 1.27.

A verified statement of small entity status under 37 CFR 1.27:

- ☐ is enclosed.
- ☒ has already been filed in this application.

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- ☐ A check in the amount of the fee is enclosed.
- ☒ The Commissioner has already been authorized to charge fees in this application to a Deposit Account. A duplicate copy of this sheet is enclosed.
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Signature

Philip G. Meyers, Reg. No. 30,478

Dated: August 18, 2003

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

#25  
10/15/03  
A.W.

In re Application of: Brock et al.

Atty Docket Number: 118776-1001

Serial No.: 09/327,593

Filed: June 8, 1999

Examiner: S. Rimmel

Art Unit: 2166

**RECEIVED**

For: INTERCHANGEABLE PANEL MODULAR DISPLAY

AUG 28 2003

Technology Center 2100

**BRIEF ON APPEAL**

Assistant Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450 on August 18, 2003.  
*Donna Turner*  
Donna Turner

**REAL PARTY IN INTEREST**

The real party in interest is Mary Farmer Brock, having a place of business at 7 Stillwaters, Rockwall, Texas.

**RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

**STATUS OF THE CLAIMS**

Claims 3-7, 12-13, 18-21, 23-28 are rejected. Claims 10, 11, 14-17 and 22 are allowed. Claims 2 and 9 were objected to. The final action states that claims 18-28 are rejected (item 6), but this is inconsistent with item 5 just above it which states that claim 22 is allowed, and with the rest of the action which indicates that claim 22 is allowed.

## STATUS OF AMENDMENTS

An Amendment after Final Action was submitted on February 18, 2003, but was refused entry in an Advisory Action mailed April 22, 2003. The appendix to this brief shows the claims without the amendments after final entered.

## SUMMARY OF THE INVENTION

The claims on appeal relate to an interchangeable panel display system and a kit for making such a display. The invention relates to *miniature* displays such as doll houses, dioramas, stage setups in the theater industry, and interior or exterior design concepts. According to claim 19 on appeal, an interchangeable panel display system includes a frame (10) including a base (12), and a first wall section (14) positionable in an upright position when the base (12) is placed horizontally on a surface. The first wall section (14) has grooves (24A, 34A) for slidably receiving a wall panel (20A) therein and an opening (28A) for inserting a wall panel (20A) into the grooves (24A, 34A) and for removing the wall panel (20A) from the grooves (24A, 34A). A second wall section (14) is positionable in an upright position when the base (12) is placed horizontally on a surface, which second wall section (14) has grooves (24B, 34B) for slidably receiving a wall panel (20B) therein and an opening (28B) for inserting a wall panel (20B) into the grooves (24B, 34B) and for removing the wall panel (20B) from the grooves (24B, 34B). The assignment of one long wall section and one short section in the reference numbered description above is arbitrary and for illustration purposes only.

First wall panel (20A) is slidably insertable into and removable from the grooves (24A, 34A) of the first wall section (14). The first wall panel (20A) comprises a support (45) having a

first decorative surface disposed on at least one side of the support (45), which decorative surface has a first design thereon. A second wall panel (20B) is slidably insertable into and removable from the grooves (24B, 34B) of the second wall section (14), the second wall panel (20B) comprising a support (45) having a decorative surface disposed on at least one side of the support (45), which decorative surface has a second design thereon that is different from the first design. The first and second designs, such as from the outsides of decorative cover sheets (49), cooperate to depict a predetermined miniature environment such as a doll house. In various dependent claims, the environment is further defined as miniature interior building decor (claim 20), especially adjacent walls of an interior room (claim 21), outdoor scenery (claim 26), a miniature representation of an object (claim 27) such as a door or window (46) (claim 28). The emphasis in this appeal is on the concept of an interchangeable display system using wall panels having miniature designs thereon, not on the structural details of the illustrated embodiments to which many of the allowed claims relate.

Claim 12 on appeal relates to an interchangeable panel display kit usable to make an interchangeable panel modular display system such as the one defined in claim 19. The display system includes a frame (10) with a base (12) and at least one wall section (14) positionable in an upright position when the base (12) is placed horizontally on a surface. The wall section (14) has grooves (24A, 34A or 24B, 34B) for slidably receiving a wall panel (20A, 20B) therein and an opening (28A, 28B) for inserting a wall panel (20A, 20B) into the grooves (24A, 34A or 24B, 34B) and for removing the wall panel (20A, 20B) from the grooves (24A, 34A or 24B, 34B). A wall panel (20A, 20B) is slidably insertable into the grooves (24A, 34A or 24B, 34B) of the wall section (14), the wall panel comprising a support (45) and a decorative surface disposed on at

least one side of the support (45), which decorative surface has a design thereon that corresponds to a miniature environment that the interchangeable display system simulates. The kit itself includes at least one frame (10) and a plurality of interchangeable wall panels (20A, 20B) having a variety of decorative surface designs so that the appearance of the display system can be changed by removal and replacement of the wall panels (20A, 20B). Claim 12 requires “a variety of designs” not just one, which designs are different from each other in order to create a variety.

It is to be emphasized that the invention relates to *miniature* displays. The claims do not, and were never intended to, read on full-size structures. This limitation is expressed, among other ways, by the limitations “wherein the first and second designs cooperate to depict a predetermined miniature environment” in claim 19 and “which decorative surface has a design thereon that corresponds to a miniature environment that the interchangeable display system simulates” in claim 12.

### ISSUES

Are claims 3-7, 12-13 and 18-21 properly rejected under 35 USC 102(b) as anticipated by Sauder U.S. Patent No. 3,975,876?

Are claims 23-28 properly rejected under 35 USC 103(a) as unpatentable over Sauder alone?

Are claims 23-28 properly rejected under 35 USC 103(a) as unpatentable over Sauder in view of French U.S. Patent No. 5,261,849?

## GROUPING OF THE CLAIMS

The grouping of the claims is as follows:

Claims 19 and 3-7;

Claim 12;

Claim 13;

Claims 18 and 20, 21, 23-28.

To the extent the foregoing groups are argued separately in the argument that follows, the claims on appeal do not stand or fall together.

## ARGUMENT

### 1. The Rejection under 35 USC 102 based on Sauder

The examiner rejected both of the independent claims on appeal as anticipated by a single reference, Sauder U.S. Patent No. 3,975,876. Sauder describes a wood frame building wall that is full size (not miniature), and not described as decorated in any specific way. It is cited mainly for structural details of the panels it uses, which are of course are full size. As to appellants' attempt to claim a display such as a doll house, the examiner responded:

With respect to the surface designs on the walls, it is noted that a blank wall would read on a surface design that is a "miniature building decor". Since the phrase "miniature building decor" is broad enough to include blank walls, the set of blank walls shown by Sauder will read as such a decor. (Final Action, page 2)

Appellant disagrees with the examiner's statement that "miniature building decor" is broad enough to include blank walls. Claims 12 and 19 each require a design. Common definitions of this word are "the arrangement of elements or details in a product or work of art" and "a

decorative pattern.” (The Merriam-Webster Dictionary, Home and Office Edition). How does a blank wall form a decorative pattern of any sort?

During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000); MPEP 2111. The examiner’s position is neither reasonable nor consistent with the specification. He is saying in effect that no design at all is a design. This would entirely defeat the purpose of the invention, which is to provide a variety of designs on interchangeable wall panels. Appellants give many examples of what they meant by “design” in the context of the invention. Claims 23-28 list a number of these, and the examiner has not rejected these claims as anticipated by Sauder. However, since designs can exist in many forms, appellants are compelled to seek more generic claims not limited to the specific examples in the specification. The examiner should note that, with appellant having made these arguments on appeal and during prosecution, there is no way that the claims would ever be interpreted by a court as covering blank walls, because appellants have disclaimed such an interpretation during prosecution.

The examiner further disregards the specific language of the claims on appeal. Claim 19 requires a “decorative surface has a second design thereon that is different from the first design, wherein the first and second designs cooperate to depict a predetermined miniature environment.” The designs cannot be the same, hence they cannot both be blank walls. Further, whatever the designs are, they must depict a *miniature* environment. The examples in the specification make clear what this means: if the design includes a door and window, the door and window are smaller than a real door and window would be in a full size structure such as Sauder’s. A pair of blank

walls don't suggest any environment at all, let alone a miniature one.

Claim 12 requires at least two different designs, and further requires that the designs correspond to a "miniature environment that the interchangeable display system simulates". As discussed in the summary of the invention above, claim 12 defines a kit (not the display itself) with multiple panel sets for use in the same slots. This is not taught by Sauder, which is in a different technical field. In building a housing structure, the walls become permanent once the house is assembled, and there is no teaching that a set of extra walls with different decorative patterns from the walls used in the structure be provided. Thus, even under the examiner's unreasonable interpretation of appellants' claims, Sauder by itself does not anticipate claims 12 and 19 on appeal.

The examiner also gives no weight to the preamble of either independent claim. Sauder describes a wood frame building wall. Claim 19 is directed to an interchangeable panel display system, and claim 12 is a kit for making an interchangeable panel modular display system. Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). As discussed in MPEP 2111.02:

"[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See also *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) (A preamble reciting "An abrasive article" was



deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable inter alia of use as abrasive grains and a binder is not an 'abrasive article.'" Therefore, the preamble served to further define the structure of the article produced.).

As this example suggests, the preamble is meaningful in distinguishing a broadly claimed article from other different articles that made from similar components but fundamentally different in nature. So it is with wood frame buildings and displays for miniature environments such as doll houses. For all of the foregoing reasons, the anticipation rejection based on Sauder should be reversed.

2. The Rejection under 35 USC 103 based on Sauder or Sauder in view of French

The examiner rejects claims 23-28 requiring specific decorative patterns under 35 USC 103 on the basis of Sauder in view of French U.S. Patent No. 5,261,849. French describes a puppet theater which does at least fall within the same field of art as appellants' display system.

In describing French, the examiner states:

French teaches a rectangular frame building (14) in which wall panels (28) can be inserted within the frame. As seen in FIG. 3, the panels are painted with indicia representing outdoor scenery, a miniature object (60) which also reads as a painting and outdoor scenery (houses and hills). It would have been obvious to one of ordinary skill in the art to modify the building walls of Sauder to include the specific indicia of French for purposes of design, amusement or entertainment, as taught by French (col. 1, lines 63-65 of French.)

Appellant disagrees for a number of reasons. First, element 14 is a top panel; there is no reference to a rectangular frame building anywhere in French. The examiner may be trying to refer to

rectangular shell or housing 12 of theater 10.

Second, as argued in the amendment after final, these references come from non-analogous arts. Under the two-step test for determining whether a prior art reference is nonanalogous and thus not relevant in determining obviousness, it must be determined (1) whether the reference is "within the field of the inventor's endeavor," and (2) if not, whether the reference is "reasonably pertinent to the particular problem with which the inventor was involved." The claimed invention and reference patents are within the same field of endeavor if they have essentially the same function and structure (such as pumps and compressors of the double-acting piston type). A cross reference in the official PTO search notes is some evidence of analogy, particularly when "nearly identical classifications of the application and references . . . are the result of the close similarity in structure and function of the invention and the prior art." *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); MPEP 2141.01(a). In this instance, the cited references have radically different classification (class 52, static structures, versus class 446, amusement devices/toys). There is no similarity in structure or function, beyond the fact that both a house and a puppet theater and about a million other objects have a generally rectangular housing or frame of some kind. Do persons in the housing construction industry look to the toy art for their methods? The undersigned hopes not.

Moving to the suggested basis for the combination, the passage cited by the examiner reads: "... present different scenic settings and background, all in such a way as to encourage a child's dramatic skills and creativity." So the examiner's position is that a person in the construction industry will take *miniature* designs from a sliding panel in a puppet theater and use them on full size walls? And he will do this to stimulate a child's dramatic skills and creativity?

Perhaps the examiner could expand on this reasoning further in his answer.

The panels of a wood frame building wall are not by nature intended to be interchangeable or even removable after the building is completed. In a puppet theater, on the other hand, a changeable background is used for changes in scene. There is no basis for combining these references, even assuming for the sake of argument only that they are analogous, for at least two reasons. First, the examiner has provided no convincing reason why one seeking to build a wood frame wall section would use interchangeable panels as the claims on appeal require. Second, the examiner has provided no convincing reason why one seeking to build a wood frame wall section would decorate it with *miniature* scenery - certainly not to stimulate a child's dramatic skills and creativity. There is, therefore, no basis for combining the cited references for purposes of 35 USC 103.

Finally, even if the references were somehow combinable, the resulting combination would not in any case be what appellants claim. Taking the examiner at his word, we have a wood frame house with a panel that is loose enough to slide out and which is decorated with tiny puppet show scenes that one of ordinary skill in the art would be more likely to consider vandalism than decorations. As noted above, claim 19 is directed to a display system with first and second designs that cooperate to depict a predetermined miniature environment, and claim 12 is a kit providing excess panels with a variety of designs. For all of the foregoing reasons, the rejection under 35 USC 103 should be reversed.

The examiner also rejects claims 23-28 as obvious over Sauder without reliance on any secondary reference, based on the observation that it would be obvious to "apply indicia to the walls of Sauder for the purpose and advantage of interior decoration." This rejection is likewise

unsupportable. Claims 23-28 relate to specific miniature decorations. In light of the preamble and other limitations of these claims, it is unreasonable to read them onto a decorated house structure without selectively ignoring many claim limitations, as discussed above. The examiner has not in this instance even cited a reference in support of his view that it would be obvious to decorate the walls of a full size house with miniature doors and windows (claim 25), for example.

While he has not expressly made a printed matter rejection, the examiner seems to hold a deep abiding conviction that limitations relating to decoration hold no weight in mechanical claims. This belief is contrary to law. Limitations which relate to the printed matter are proper and cannot be disregarded when determining patentability. The Federal Circuit made this clear in *In re Gulack*, 217 USPQ 401, 403 (Fed. Cir. 1983):

Differences between an invention and the prior art cited against cannot be ignored merely because those differences reside in the content of the printed matter. Under section 103, the Board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole.

The examiner in this appeal is not reading the claims as a whole. The preamble of the claim is entitled to weight, as are the limitations relating to the nature of the designs and their size.

### 3. Claim 13

In the amendment after final which the examiner refused to enter, appellant attempted to further limit claim 12 by combining it with claim 13. Claim 13 provides that the frame defines a plurality of wall sections, and the wall panels include subsets of two or more panels (20A, 20B) having matching or coordinated decorative covers (49). Accordingly the *minimum configuration*

for this claim is:

a frame

at least two wall sections and associated slots

at least two panels in the first subset with matching or coordinated covers

and at least two panels in the second subset also with matching or coordinated covers.

The covers of the second subset are different from those of the first subset, otherwise there is no variety of designs as required by claim 12. The references in the rejections discussed above do not teach or suggest a *kit* (not a finished display or a wood frame building) having multiple sets of multiple interchangeable panels per set.

4. Claims 18, 21, 23-28

This group of claims is patentable over the cited references for the reasons discussed in connection with the rejections of claims 23-28 above. The examiner distinguishes claims 18, 21 from claims 23-28, maintaining, as quoted above, that “miniature interior building decor” reads on blank walls. “Decor” is commonly defined as “the style and layout of interior furnishings” (Webster’s, cited above.) In what manner does a blank wall convey an impression of style or layout? Here again appellant believes the examiner is reading the words used in the claims with unreasonable breadth not supported by common usage or by the examples given in appellants’ specification.

CONCLUSION

For all of the foregoing reasons, the claims on appeal define patentable subject matter within the meaning of 35 USC 103 in view of the prior art cited by the examiner and are not

anticipated within the meaning of 35 USC 102. Accordingly, it is respectfully requested that the Board reverse the rejections and indicate that a notice of allowance respecting all pending claims be issued.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Philip G. Meyers", written over a horizontal line.

Philip G. Meyers  
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Dated: August 18, 2003

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## APPENDIX - THE CLAIMS ON APPEAL

The claims are listed in groups based on dependency rather than in numerical order:

19. An interchangeable panel display system, comprising:

a frame including a base, a first wall section positionable in an upright position when the base is placed horizontally on a surface, which first wall section has grooves for slidably receiving a wall panel therein and an opening for inserting a wall panel into the grooves and for removing the wall panel from the grooves, and a second wall section positionable in an upright position when the base is placed horizontally on a surface, which second wall section has grooves for slidably receiving a wall panel therein and an opening for inserting a wall panel into the grooves and for removing the wall panel from the grooves; and

a first wall panel slidably insertable into and removable from the grooves of the first wall section, the first wall panel comprising a support having a first decorative surface disposed on at least one side of the support, which decorative surface has a first design thereon; and

a second wall panel slidably insertable into and removable from the grooves of the second wall section, the second wall panel comprising a support having a decorative surface disposed on at least one side of the support, which decorative surface has a second design thereon that is different from the first design, wherein the first and second designs cooperate to depict a predetermined miniature environment.

2. The display system of Claim 19, wherein the decorative surface comprises a decorative cover, and the wall panel further comprises a magnetically attractable layer disposed on one side of the support beneath the cover.

3. The display system of Claim 19, wherein the base and wall sections are each rectangular, and the wall section is mounted along one edge of the base section.

4. The display system of Claim 3, wherein the wall section comprises two parallel, spaced, upright posts, each post having a longitudinal groove for slidably receiving the wall panel therein.

5. The display system of Claim 4, wherein the base includes a groove in alignment with the longitudinal grooves in the posts and spanning the posts for receiving a lower edge of the wall panel therein.

6. The display system of Claim 19, wherein the wall section comprises an open rectangular frame having a pair of parallel posts mounted at two adjacent corners of the base and a beam spanning upper ends of each post, each post having a longitudinal, inwardly facing groove for slidably receiving the wall panel therein, and the beam having a slot therethrough in alignment with the grooves in the posts, which slot comprises the opening in the frame for inserting the wall panel.

7. The display system of Claim 3, wherein the frame comprises four wall sections which include four posts mounted at four corners of the base and four upper beams spanning the four posts, wherein at least three wall sections comprise an open rectangular frame defined by:

a pair of parallel posts mounted at two adjacent corners of the base with one of the beams spanning upper ends of the pair of posts, each post of the pair having a longitudinal, inwardly



facing groove for slidably receiving the wall panel therein, and the beam having a slot therethrough in alignment with the grooves in the posts, which slot comprises the opening in the frame for inserting the wall panel.

9. The display system of Claim 2, further comprising one or more magnetically attractable decorations, wherein at least one of the decorations and the magnetically attractable layer of the wall panel comprises a magnetic material.

20. The display system of Claim 19, wherein the predetermined miniature environment comprises miniature interior building decor.

21. The display system of Claim 20, wherein the first and second wall panels simulate in miniature adjacent walls of an interior room.

26. The display system of Claim 19, wherein the predetermined miniature environment comprises outdoor scenery.

27. The display system of Claim 20, wherein one of the first and second designs includes a miniature representation of an object.

28. The display system of claim 27, wherein the object is selected from a door, window, painting or shelf.

12. An interchangeable panel display kit usable to make an interchangeable panel modular display system, which display system includes a frame including a base and at least one wall section positionable in an upright position when the base is placed horizontally on a surface, which wall section has grooves for slidably receiving a wall panel therein and an opening for inserting a wall panel into the grooves and for removing the wall panel from the grooves, and at least one wall panel slidably insertable into the grooves of the wall section, the wall panel comprising a support and a decorative surface disposed on at least one side of the support, which decorative surface has a design thereon that corresponds to a miniature environment that the interchangeable display system simulates, wherein the kit comprises:

at least one frame; and

a plurality of interchangeable wall panels having a variety of decorative surface designs so that the appearance of the display system can be changed by removal and replacement of the wall panels.

13. The kit of claim 12, wherein the frame defines a plurality of wall sections, and the wall panels include subsets of two or more panels having a matching or coordinated decorative covers.

18. The kit of Claim 12, wherein the decorative surface designs each comprise miniature interior building decor.

23. The kit of Claim 12, wherein one or more of the decorative surface designs are selected from wallpaper, a mural, and outdoor scenery.

24. The kit of Claim 18, wherein one or more of the decorative surface designs include a miniature representation of an object.

25. The kit of claim 24, wherein the object is selected from a door, window, painting or shelf.